

REMARKS

In the instant Office Action dated July 29, 2008, claim 10 has been identified as containing allowable subject matter and the following rejections have been noted: claims 2-9 stand provisionally rejected due to obviousness-type double patenting over claims 2-9 and 19-21 of co-pending Application No. 09/912,470; claims 11-21 stand rejected under 35 U.S.C. § 112(1); claims 4 and 6-9 stand rejected under 35 U.S.C. § 103(a) over the Murch reference (US Patent No. 5,764,190) in view of the Lindmark reference (U.S. Patent No. 6,054,953); and claims 2-3 and 5 stand rejected under 35 U.S.C. § 103(a) over the Murch and Lindmark references in view of the Engblom reference (U.S. Patent No. 6,002,367). Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

With respect to the provisional rejection, Applicant respectfully traverses on the bases that the asserted correspondence between the identified claims is lacking and that the asserted motivation is insufficient. For examples of lacking correspondence, reference may be made to Applicant's claim limitations concerning the arrangement of the capacitor and the slot. Regarding the issue of motivation, Applicant submits that the skilled artisan would not be so motivated as the asserted motivation would appear to undermine the stated purpose and operation of the '470 reference as set forth at paragraphs 4-7 of the published version of the '470 reference (the problem of known antenna arrangements coupling strongly to the terminal case and the radiation that emanates from the terminal itself rather than the antenna, and the '470 solution concerning efficient radiation properties over a wide bandwidth by using a ground conductor and a transceiver coupled to an antenna feed, wherein the antenna feed is coupled to the ground conductor). By modifying the '470 reference as taught by the cited teachings of Lindmark and Hines, this hypothetical prior art would appear to be well outside the scope of the stated purpose and operation of the '470 reference. According to M.P.E.P. § 2143.01 (V), the § 103 requirements for the provisional rejection fail - because "the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." Thus, the rejection is improper and should be withdrawn.

While the provisional rejection might also be overcome by a properly-executed terminal disclaimer, the instant record evidences that such a disclaimer is unwarranted. Moreover, at this time, common assignment for the subject application is unclear.

Applicant traverses each of the § 103(a) rejections because the rejections are not supported by the requisite correspondence from the asserted teachings of the references and because the Office Action fails to provide a valid reason for the proposed combination. This approach is contrary to the requirements of Section 103 and relevant law. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007) (“A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.”). See also www.iptoday.com/articles/2007-09-nowotarski.asp. Notwithstanding these deficiencies, Applicant has amended independent claim 9 to specify that the capacitor is arranged in combination with the slot to facilitate a shunt inductance at the antenna feed. The asserted combination of teachings fails to correspond to the claimed invention. Thus, these § 103(a) rejections are overcome.

Turning now to the § 112(1) rejections, Applicant respectfully traverses each. The alleged failure to comply with the § 112(1) written description requirement is in error. According to M.P.E.P. § 2163 (I), the written description requirement is satisfied with a showing that patent specification, as originally filed, describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention, and it is well accepted that a satisfactory description may be in the claims or “any other portion” of the originally filed specification including “such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.” The Office Action cites Applicant’s support in the Specification at paragraph 37. Applicant also refers the Examiner to paragraph 46 and to Figures 9 and 12 (and the related discussion) of the Specification which show that the patent specification, as originally filed, describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Thus, paragraph 46 of the Specification explains that “The self-resonance of each slot 912,1214 is independently variable via its position under the feeding capacitor 504: as the slot 912,1214 is

progressively moved under the plate 506 the effect of its nominal shunt inductance increases....”

Applicant similarly submits that the alleged failure to comply with the § 112(1) enablement requirement is in error. According to M.P.E.P. § 2164, the § 112(1) enablement requirement is satisfied when the specification describes how to make and how to use the invention. The rejection, however, fails to raise any concern over whether Applicant’s Specification describes how to make and how to use the invention; rather, the rejection is carried by an unsupported argument that the claim is not enabled by Applicant’s disclosure which unquestionably presents the appropriate level of teaching to satisfy the subject § 112(1) requirement. The Examiner’s reliance on *In re Mayhem* is misplaced as the Guidelines for Examination of Patent Applications Under the 35 U.S.C. §112 explains that there is limited support for such a rejection when based on matter omitted from the claim where the matter disclosed as being essential to the invention as described in the specification or in other statements of record. In this instance, the rejection is based on a “belief” statement in Applicant’s Specification (“It is believed that ...”). Thus, not only does the Specification fail to allege that the omitted matter is essential, the relied-upon statement from the Specification avers only that there might be a relationship. The Examiner has provided no support whatever that the omitted matter is essential. As explained at § 2164.04, the Examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure. Citing *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993). The applicable section from the M.P.E.P. is § 2164.06(a) which provides examples of the types of cases where such a rejection might be applicable where the disclosure (as opposed to a claim) is not enabling.

Accordingly, Applicant submits that the rejection is flawed and must be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9068.

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